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EXAMINER

APPLE, KIRSTEN SACHWITZ

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LIMOR SCHWEITZER

Appeal 2009-012322
Application 09/879,682
Technology Center 3600

Before HUBERT C. LORIN, ANTON W. FETTING and
MEREDITH C. PETRAVICK, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Limor Schweitzer (Appellant) seeks our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-36. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE and enter a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).¹

THE INVENTION

This invention is a system, method and computer program product for providing prepaid wireless voice communication and Internet Protocol services. A digital wallet in the form of a prepaid debit account is created and payment is collected by billing against the prepaid debit account *prior* to allowing wireless network voice communication and IP usage over the wireless network. Spec. 5:1-10.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method for providing a digital wallet for Internet Protocol (IP) usage utilizing a wireless network, comprising:
 - (a) prior to allowing wireless network voice communication and IP usage over a wireless network, receiving a request for a pre-paid debit account including payment therefor;

¹ Our decision will make reference to the Appellant's Appeal Brief ("App. Br.," filed January 9, 2008), Appellant's Reply Brief ("Reply Br.," filed July 8, 2008) and the Examiner's Answer ("Answer," mailed May 8, 2008).

- (b) prior to allowing the wireless network voice communication and the IP usage over the wireless network, enabling the pre-paid debit account in response to the request;
- (c) collecting payment for the wireless network voice communication over the wireless network by billing against the pre-paid debit account; and
- (d) collecting payment for the IP usage by billing against the pre-paid debit account, wherein the IP usage is carried out using the wireless network.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Foladare	US 5,914,472	Jun. 22, 1999
Holm-Blagg	US 2004/0030657 A1	Feb. 12, 2004
Hultgren	US 6,868,391 B1	Mar. 15, 2005

The Examiner took Official Notice that “mobile phone usage (including voice and IP) is a well know [sic - known] utility.” Answer 4. [Hereinafter “Official Notice I”].

The Examiner took Official Notice that “WAP is a commonly used protocol for developing wireless applications and could be used for developing a mobile payment system.” Answer 5. [Hereinafter “Official Notice II”].

The Examiner took Official Notice that “any variable set by the user can have time limits associated with it.” Answer 6. [Hereinafter “Official Notice III”].

The following rejections are before us for review:

1. Claims 1-11, 18-28, and 35-36 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hultgren and Official Notice I-II.

2. Claims 12-15 and 29 -32 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hultgren, Official Notice I-III and Foladare.
3. Claims 16-17 and 33-34 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hultgren, Official Notice I-III, Foladare and Holm-Blagg.

ISSUE

The issue is whether claims 1-11, 18-28, and 35-36 are unpatentable over Hultgren and Official Notice I-II. Specifically, the issue is whether the Examiner erred in finding that Hultgren's Figure 3A-3C teaches steps 1(a) - 1(d) recited in claim 1. The rejection of claims 12-15 and 29-32 under 35 U.S.C. §103(a) as being unpatentable over Hultgren, Official Notice I-III and Foladare and the rejection of claims 16-17 and 33-34 under 35 U.S.C. §103(a) as being unpatentable over Hultgren, Official Notice I-III, Foladare and Holm-Blagg also turn on this issue.

FINDING OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Hultgren's Figure 3A is reproduced below.

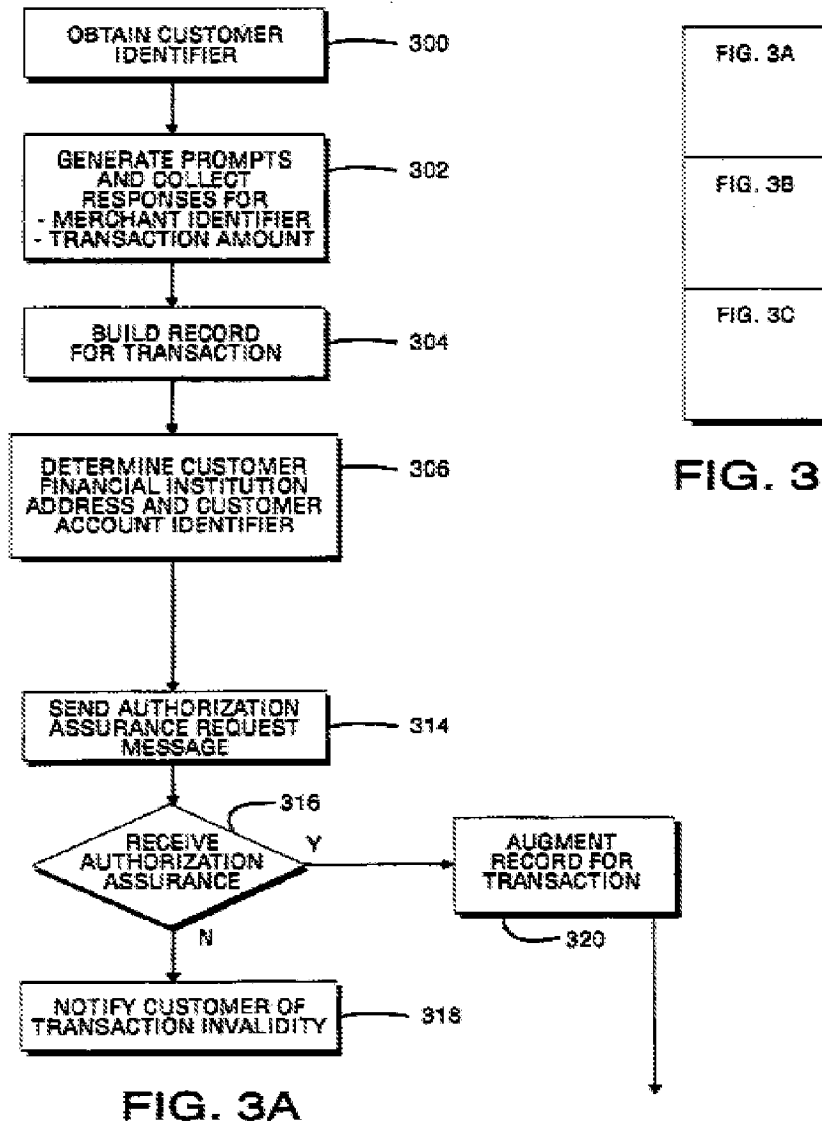


Figure 3A depicts a flow chart of a method (col. 3, ll. 3-5) and includes item 300, which “obtains a customer identifier” (see col. 6, ll. 22-26).

2. Step 300 in FIG. 3A describes that “[a] telepay TSN **30**, upon initially handling the call customer communications, module **202** obtains a customer identifier (e.g. customer directory number) from the call signaling which sets up the call (see step **300** in FIG. 3A).” *See* col. 6, ll. 23-27.
3. Step 304 of FIG. 3A describes that “[t]hus far, therefore, the record for the call includes the unique transaction code, the customer identifier, the merchant identifier, and the transaction amount.” *See* col. 6, lines 63-65.
4. Step 306 of FIG. 3A describes that “telepay TSN **30** determines the customer financial institution address and the customer account identifier at the customer financial institution.” *See* col. 6, ll. 66 – col. 7, ll. 1.
5. Step 314 of FIG. 3A describes that “customer financial institution interface **208-1** is directed to send the customer financial institution an authorization assurance request message” (*see* col. 7, ll. 19-24) and this authorization assurance request message “includes the transaction code, the customer account identifier, the transaction amount, and a message type code.” *See* col. 7, ll. 27-34.
6. Step 316 of FIG. 3A describes that “if the authorization assurance message is negative (indication that authorization is not granted), an invalid transaction notification is sent” (*see* col. 7, ll. 39-42) and that “[o]therwise, as shown by step **320**, the customer financial institution address and customer account identifier obtained from step **306**, along with an indication of receipt of positive authorization assurance

- message, are stored in the record for the current transaction in transaction database **220**.” *See* col. 7, line 42-47.
7. Step 328 of FIG. 3B shows “receipt of the transaction verification message from customer mobile station **60**.” *See* col. 8, ll. 26-28.
 8. Hultgren describes “at step **334** transfer coordination module **206** directs that a transaction verification request message be sent to merchant terminal **70**.” *See* col. 8, ll. 32-34.
 9. Hultgren describes that at step 344 of FIG. 3C “[w]ith the transaction approved by both parties, at step **344** transfer coordination module **206** directs the funds transfer authorization module **210** to authorize initiation of transfer of the transaction amount from the customer account to the merchant account.” *See* col. 8, ll. 66 –col. 9, ll. 3.
 10. Hultgren describes that “[s]tep **348** also shows transfer coordination module **206** sending a funds transfer requested notification message to merchant financial institution **90** over data network N” and the notification message “alerts institution **90** to expect to receive *eventually* a transfer of the transaction amount to the merchant account.” *See* col. 9, lines 27-35 (emphasis added).

ANALYSIS

The rejection of claims 1-11, 18-28 and 35-36 under 35 U.S.C. §103(a) as being unpatentable over Hultgren and Official Notice I-II

We agree with the Appellant (App. Br. 11-12 and Reply Br. 2-5) that Figure 3A of Hultgren fails to teach step 1(a). Step 1(a) recites receiving a request for a pre-paid account including *payment therefor*. To teach this

step, the Examiner relies on Figure 3A, item 300 of Hultgren. Answer 3 and 8. Item 300 teaches obtaining a customer identifier, which the Examiner equates to receiving a request for an account (Answer 3-4 and 8-9). The Examiner relies on item 300 to teach a request for an account with payment therefor. However, the customer identifier of item 300 does not include a payment as required by the recited step 1(a). FF 1-3. Hultgren fails to teach the payment recited in step 1(a) and the Examiner provides no other explanation with logical underpinnings or evidence to teach this limitation. The Examiner also does not rely upon Official Notice I-II to teach this limitation.

We note that the method depicted in Hultgren's Figures 3A-3C does describe steps for sending a transaction verification request message, receiving an authorization assurance and generating a funds transfer request notification from an account (i.e. items 306, 314, 316, 328, 334, 344 and 348). However, the funds transfer requested notification message in item 348 is sent to alert the institution to expect to receive *eventually* a transfer of the transaction amount. FF 10. The Examiner has relied upon these items to teach claimed steps 1(b)-(d), which recite enabling an account and collecting payments prior to allowing the wireless network voice communication and the IP usage (Answer 3-4 and 8-9). Hultgren's items 306, 314 and 316 do not teach enabling a debit account as required by the recited step 1(b). FF 4-6. Hultgren's items 328, 334, 344, and 348 do not include a payment as required in steps 1(c) and 1(d). *See* FF 7-10.

Therefore, we find that the Examiner has failed to establish a *prima facie* showing of obviousness in rejecting claim 1. Independent claims 18, 35, and 36 recite similar limitations and are rejected using the same

rationale, which we find deficient above. Answer 3-4. Accordingly, we reverse the rejection of claims 1, 18, 35, and 36, and claims 2-11, 19 and 20-28, dependent thereon, under 35 U.S.C. § 103(a) as being unpatentable over Hultgren and Official Notice I-II.

The rejection of claims 12-15 and 29-32 under 35 U.S.C. §103(a) as being unpatentable over Hultgren, Foladare, and Official Notice I-III

This rejection is directed to claims dependent on claims 1 and 18 whose rejection we have reversed above. For the same reasons, we will not sustain the rejections of claims 12-15 and 29-32 over the cited prior art. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious.”). We note that the Examiner did not rely upon Foladare or Official Notice III to cure the deficiencies discussed above with regards to the rejection of claims 1 and 18. Accordingly, the rejection of claims 12-15 and 29-32 as unpatentable under 35 U.S.C. § 103(a) over Hultgren, Foladare, and Official Notice I-III is reversed.

The rejection of claims 16-17 and 33-34 under 35 U.S.C. § 103(a) as being unpatentable over Hultgren, Official Notice I-III, Foladare, and Holm-Blagg

This rejection is directed to claims dependent on claims 1 and 18 whose rejection we have reversed above. For the same reasons, we will not sustain the rejections of claims 16-17 and 33-34 over the cited prior art. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious.”). We note that the Examiner did not rely upon Foladare,

Official Notice III, or Holm-Blagg to cure the deficiencies discussed above with regards to the rejection of claims 1 and 18. Accordingly, the rejection of claims 16-17 and 33-34 as unpatentable under 35 U.S.C. § 103(a) over Hultgren, Official Notice I-III, Foladare, and Holm-Blagg is reversed.

NEW GROUND OF REJECTION

Pursuant to 37 C.F.R. § 41.50(b), we enter a new ground of rejection on claim 35. We reject claim 35 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

The preamble of claim 35 recites “[a] system including a computer readable medium” and the body of claim 35 recites “logic.” Giving this claim the broadest reasonable construction in light of the Specification, we find that this claim encompasses a system that includes nothing more than instructions being disposed on transitory propagating signals *per se*². We note that the Specification is silent as to what a “computer readable medium” or “system” encompasses. A signal does not fit within at least one of the four statutory subject matter categories under 35 U.S.C. § 101. *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007). Accordingly, claim 35 is rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter for encompassing a signal.

² See *Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010).

DECISION

The decision of the Examiner to reject claims 1-36 is reversed. We enter a new ground of rejection on claim 35.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” 37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

REVERSED; 37 C.F.R. § 41.50b)

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